

REMARKS

Claims 76-142 are pending. Claims 76-86, 90, 92-99, 103, 105-140 and 142 are under examination. New claims 143 and 144 were added in the response mailed March 24, 2005. Entry of the previous response mailed March 24, 2005, is respectfully requested.

Applicants further request entry of the amendments and consideration of the remarks submitted herein. Claims 128-131, 133, 136 and 137 have been canceled. Claims 106, 121, 132, 134, 135, 138, 140 and 142-144 have been amended. New claims 145 and 146 have been added. Support for the amendments and new claims can be found throughout the specification and the claims as filed. In particular, support for the amendment of claims 121, 138 and 142 can be found, for example, in original claim 76, Figure 1, and on page 22, line 20, to page 23, line 14. Claims 132, 134 and 135 have been amended to correct antecedent basis. Support for new claims 145 and 146 can be found, for example, on page 23, lines 8-12. Accordingly, these amendments and new claims do not raise an issue of new matter and entry thereof is respectfully requested.

Regarding the Change of Inventorship

Applicants respectfully maintain, for the reasons of record, that the requirements for changing inventorship have been presented. Nevertheless, Applicants submit herewith as Exhibits 1 and 2, respectively, two statements under 37 C.F.R. § 1.48(a)(5) executed on behalf of co-assignees, the University of Washington and Applera, Inc., as requested by the Examiner. A statement under 37 C.F.R. § 1.48(a)(5) executed on behalf of the Institute for Systems Biology was previously submitted on July 7, 2003. Accordingly, Applicants respectfully request that the request for change of inventorship be granted.

Regarding the Rejection Under 35 U.S.C. § 112, First Paragraph

The rejection of claims 76-86, 90, 92-99, 103, 105-120, 128-137 and 142 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement is respectfully traversed, as indicated in the Office Action dated October 4, 2004. Regarding claims 128-131, 133, 136 and 137, it is respectfully pointed out that this rejection has been rendered moot with respect to these canceled claims. Regarding claim 142, Applicants point out that claim 142 recites a specific structure

disclosed in the specification, for example, in Figure 1 and, accordingly, respectfully submit that the specification provides sufficient description and guidance to enable claim 142.

With respect to pending claims 76-86, 90, 92-99, 103, 105-120, 132, 134 and 135, Applicants maintain, for the reasons of record, that the specification provides sufficient description and guidance to enable the claimed compositions. Applicants respectfully maintain that, based on the teachings in the specification and what was well known in the art, one skilled in the art would have been enabled to make and use the invention as claimed. The specification teaches a variety of "cleavable functional groups," for example, on page 15, line 11, to page 17, line 26. In particular, the specification teaches the use of photo-cleavable groups, chemical cleavable groups, cleavage of peptides using chemical or enzymatic cleavage, and cleavage of nucleic acid with an endonuclease. The specification additionally teaches a variety of tags, for example, on page 14, line 5, to page 15, line 10, including a mass tag such as an isotope tag, differentially isotopically labeled tags, charged amino acids, isotope distribution tags, and the like. The specification further teaches a variety of well known reactive groups, for example, on page 17, line 27, to page 18, line 13. With regard to the assertion in the Office Action that very different chemistries are involved depending on the functional groups, Applicants respectfully maintain that one skilled in the art would have readily understood appropriate chemistries for particular functional groups based on the teachings in the specification and what was well known to those skilled in the art. Accordingly, it is respectfully submitted that the specification provides sufficient description and guidance to enable the claimed compositions. Therefore, Applicants respectfully request that this rejection be withdrawn.

Regarding the Rejection Under 35 U.S.C. § 112, Second Paragraph

Applicants maintain, for the reasons of record, that claims 121-140 and 142 are clear and definite. Nevertheless, Applicants have amended the claims as suggested by the Examiner to further prosecution. In particular, claims 121, 138 and 142 have been amended to provide the chemical structure, delete reference to "chemical group" and "leucine tag," designate the reactive group as "I" and designate where the isotope tag is present in the formula, as requested by the Examiner. Applicants submit that claims 121-140 and 142 are clear and definite and, accordingly, respectfully request that this rejection be withdrawn.

In light of the amendments and remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned agent if there are any questions.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Deborah L. Cadena". The signature is fluid and cursive, with the first name being the most prominent.

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